

## **REMARKS**

### **Status of Claims**

In the present application Claims 1-7, 9-12, 14-16, 27-50, and 59-78 are pending, of which Claims 1, 27 and 35 are independent claims.

No claim amendment is requested in this Request for Reconsideration; however, for the convenience of the Examiner, all pending claims are reproduced as an attachment entitled "Claims".

In the Office Action, Claims 1, 2, 7, 9, 10, 15, 16, 27-32, 34, 35, 38-44, 49, 50 and 62-76 were rejected under 35 U.S.C. §103(a) as allegedly unpatentable over Alemaný et al. (U.S. Pat. No. 4,834,735) in view of Newkirk et al. (U.S. Pat. No. 5,143,779); Claims 3-6, 11, 33, 37, 48 and 59-61 were rejected under 35 U.S.C. §103(a) as allegedly unpatentable over Alemaný et al. in view of Newkirk et al. as applied to Claim 1, 27, and 35 above, and further in view of Karami (U.S. Pat. No. 4,027,672); and Claims 12, 14, 36, 45-47, 77 and 78 were rejected under 35 U.S.C. §103(a) as allegedly unpatentable over Alemaný et al. in view of Newkirk et al. as applied to Claims 1, 27, and 35 above, and further in view of Morman (U.S. Pat. No. 5,611,879).

### **In General**

By relying on 35 U.S.C. §103(a) as grounds for rejection based on alleged obviousness in view of multiple references and by various statements throughout the detailed Office Action, the Office already acknowledges certain important deficiencies of the base reference, Alemaný, which renders Alemaný inadequate by itself as a basis for rejecting any of the Claims 1-7, 9-12, 14-16, 27-50, and 59-78. Additionally, Applicants

respectfully submit that the Office Action has failed to show that any of the cited secondary references serve to overcome the deficiencies of Aleman as explained below, and thus, all Claims 1-7, 9-12, 14-16, 27-50, and 59-78 are in condition for allowance.

Moreover, it is respectfully submitted that merely combining elements found in various prior art patents to produce the Applicants' Claim 1-7, 9-12, 14-16, 27-50, and 59-78 inventions is not a proper basis for a 35 U.S.C. § 103(a) rejection.<sup>1</sup> "Virtually all inventions are necessarily combinations of old elements. The notion, therefore, that combination claims can be declared invalid merely upon finding similar elements in separate prior patents would necessarily destroy virtually all patents and cannot be the law under the statute, '103.'"<sup>2</sup> Thus, the task of the Patent Office is essentially a burden of proof not just to show prior patents with selected elements similar to respective parts of a claimed combination, but to show teachings to support obviously combining the elements in the manner claimed. It is respectfully submitted that the Office Action fails to show where the cited references provide the motivation for obviously combining their respective technologies in the manner claimed by the Applicants in Claims 1-7, 9-12, 14-16, 27-50, and 59-78.

### **Detailed Response**

Applicants respectfully traverse the rejection of Claims 1, 2, 7, 9, 10, 15, 16, 27-32, 34, 35, 38-44, 49-50 and 62-76 under 35 U.S.C. § 103(a) as allegedly obvious over

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<sup>1</sup> Graham v. John Deere Co., 383 U.S. 1 (1966) ("Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. Under section 103, teachings of references can be combined only if there is some suggestion or incentive to do so.")(emphasis original)

<sup>2</sup> Panduit Corp. v. Dennison Manufacturing Co., 1 U.S.P.Q.2d 1593, 1603 (Fed. Cir. 1987; footnotes omitted).

Alemaný et al. in view of Newkirk et al. Claim 1, for example, recites a nonwoven web made from fibers, the fibers comprising thermoplastic fibers, said nonwoven web having a first end and a second and opposite end, said nonwoven web defining a first area having a first basis weight and a second area having a second basis weight being located on said nonwoven web according to a predetermined pattern, said first basis weight being at least about 1.5 times greater than said second basis weight, said first area comprising from about 25% to about 75% of said nonwoven web, the web being compressed and thermally bonded together. Applicants respectfully submit that the cited patents, alone or in any reasonable combination, do not disclose each and every element of Claim 1.

The Office Action admits that Alemaný fails to teach that the calendering process involves thermally bonding the fibers. Alemaný not only fails to suggest the advantageous use of a thermally bonded web, the cited reference teaches away from thermally bonding absorbent structures together as discussed in Applicants' Appeal Brief dated August 12, 2003, incorporated herein by reference. See e.g., Appeal Brief, page 5, in which Alemaný via Weisman desires to keep bonds as low as possible; i.e., to keep fiber/fiber, fiber/hydrogel, and hydrogel/hydrogel particles unbonded. Thus, the unbonded, absorbent structures of the cited reference are materially different from Claim 1.

Newkirk fails to remedy the deficiencies of Alemaný. Although the Office Action states that Newkirk teaches a nonwoven fabric having strength, softness, and compression resistance to make it suitable for use in absorbent products, Newkirk, as admitted by the Office Action, is more specifically directed to a spacer layer. The

disclosed spacer layer is not itself an absorbent structure but quickly “wicks” large “gushes” of a liquid to a separate absorbent layer. In other words, Newkirk, taken as a whole, teaches a component separate and distinct from the absorbent structures disclosed in Alemaný. Thus, the cited references are not combinable.

Although the Office Action further states that spacer layers are often thought of as being part of the core layer of an absorbent article in the art and refers to U.S. Pat. No. 5,360,420 to Cook for support, Applicants respectfully submit that such reliance is misplaced to cure the deficiencies of the cited references. Cook teaches an acquisition distribution layer (110) that holds discharged body fluid. See col. 7, lines 33-35. If an upper part of the layer (110) cannot absorb discharged fluid quickly enough, the layer (110) transports the overflow to other parts of the layer (110); i.e., to other parts of itself. See col. 7, lines 39-45. Also, a storage layer (108) in Cook does not wick fluid elsewhere since it eventually drains the layer (110) of its fluid load. See col. 19, lines 42-46. Accordingly, the layers (108, 110) of Cook are entirely different than the spacer layer of Newkirk as discussed above.

One of ordinary skill in the art would not have been motivated to thermally bond the absorbent structure of Alemaný based on the wicking spacer layer of Newkirk since doing so would materially and adversely alter Alemaný as it is suited for its intended purpose. See In re Gordon, 733 F.2d 900, 221 U.S.P.Q. 1125 (Fed. Cir. 1984)(stating that for a claim to be obvious in view of a modification of prior art, there must be some suggestion that it would be desirable to make such a modification). Accordingly, Applicants respectfully disagree that motivation for thermal bonding the web of Alemaný has been set forth in the Office Action.

Moreover, if a proposed modification or combination of prior art would change the principle of operation of the prior art invention if modified, then the teachings of the references are not sufficient to render claims *prima facie* obvious. See In re Ratti, 270 F.2d 810, 123 U.S.P.Q. 349 (CCPA 1959). By changing the unbonded absorbent structures elements of Aleman to make them bonded based on wicking material of Newkirk is a substantial redesign of the elements and a change in the basic principle under which the Aleman construction was designed to operate. 270 F.2d at 813, 123 U.S.P.Q. at 352. Thus, by combining Aleman and Newkirk, the Office Action ignores the proposition that obviousness may be rebutted by showing that the prior art teaches away from the claimed invention in a material respect. See also In re Peterson et al., 65 U.S.P.Q.2d 1379 (Fed. Cir. 2003) (citing In re Geisler, 116 F.3d 1465, 1469, 43 USPQ2d 1934, 1936-37 (CCPA 1976). Clearly, *prima facie* obviousness is rebutted in the present case.

The Applicants respectfully submit that the Examiner has failed to find any suggestion or motivation in the prior art that specifically addresses a thermally bonded absorbent core. The Examiner's failure to find prior art having the recited elements of Claim 1 only serves to highlight the non-obviousness of Claim 1. Accordingly, Applicants respectfully submit that Claim 1 is patentable over the cited references and respectfully request that the Examiner remove the rejection to Claim 1 and its dependent Claims 2-3, 9-12, 14-16, 49, 50, 59, 62-63, 74 and 77 and indicate their allowance.

With regard to the rejection of independent Claim 27 as allegedly unpatentable under 35 U.S.C. §103(a) over Aleman in view of Newkirk, in addition to at least the

reasons discussed above, the Office Action admits that Alemaný et al. does not teach a spunbonded web. Thus, Applicants respectfully submit that Claim 27 and its dependent Claims 28-34, 60, 66, 67, 75 and 78 only further particularly describe and distinctly claim their respective inventions. Applicants respectfully submit that Claim 27 is patentable over the cited references and request withdrawal of the rejection of Claim 27 and allowance of Claims 28-34, 60, 66, 67, 75 and 78.

Regarding the rejection of independent Claim 35 as allegedly unpatentable under 35 U.S.C. §103(a) over Alemaný in view of Newkirk, Applicants respectfully submit that Claim 35 and its dependent Claims 36-48, 61, 70, 71 and 76 further particularly describe and distinctly claim their respective inventions and are patentable over the cited references for at least the reasons discussed above. Accordingly, Applicants respectfully request withdrawal of the rejection of Claim 35 and allowance of Claims 35-48, 61, 70, 71 and 76.

Applicants respectfully submit that the present Request for Reconsideration raises no new issues requiring an additional search by the Examiner, responds directly to matters raised in the Office Action, and places the Application in condition for allowance.

If the Examiner has any questions upon consideration of this Request for Reconsideration, Applicants invite the Examiner to contact the undersigned at his convenience.

Please charge any additional fees required by this Request for Reconsideration to Deposit Account No. 04-1403.

Respectfully submitted,



DORITY & MANNING, P.A.



Date

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